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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/828,330	03/28/1997	WILLIAM D. MORGAN	I-852-002	4766
7590	04/04/2005		EXAMINER	
N.PAUL FRIEDERICHS ANGENEHM LAW FIRM LTD P.O.BOX 48755 COON RAPIDS, MN 55448			CANFIELD, ROBERT	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 <b>Office Action Summary</b>	Application No.	Applicant(s)	
	08/828,330	MORGAN, WILLIAM D.	
Examiner	Art Unit		
Robert J Canfield	3635		

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

### *Office Action Summary*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.13(d)(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- If extension of time is requested, a set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 December 2004.  
2a)  This action is FINAL.                    2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-12,14-16 and 18-49 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-12,14-16 and 18-49 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All   b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No./s) Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

1. This Office action is response to the amendment filed 12/24/04 for application Serial Number 08/828330. Claims 1-12, 14-16, and 18-49 are pending. Claims 13 and 17 have been canceled.

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,400,549 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

2. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-12, 14-16 and 18-49 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is that the declaration of record fails to address the changes made in the amendments of 06/07/04 and 12/24/04.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: antecedent basis should be provided in the specification for "dirty water" and "aqueous solutions".
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 6-12, 14-16 and 18-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.  
The preamble of a "pond cover" in the dependent claims does not agree with the preamble of "a cover and dirty water combination" in the independent claim rendering the intended scope of the claims indefinite.
6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 5-7, 9-12, 14, 15, 18-20, 22, 24-29, 31-38, 40-42, 44, 47 and 48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 4,197,595 to Dearing.

Dearing provides a cover for water or other liquids (Col. 1, line 9). The cover is adapted for use on ponds (Col. 1, line 34). The language "waste treatment pond cover" is nothing other than intended use. A pool is considered a "tank". Further, applicant has admitted on record that tanks are known equivalents in the art to ponds. The cover is comprised of a plurality of panels 12 having means for linking and de-linking as well as securing, locking and unlocking in the form of grommets 31 which may be tied together by fasteners of any suitable cord or other device (Col. 6, lines 66+). Dearing also provides means for anchoring and securing the panels 12 over the water in the form of straps 50, which are considered to meet the limitation of a "tie down cable". The panels themselves provide a means for controlling temperature. Cells 16 provide air as insulation inside the panels. Column 4, line 48 discusses the margins of the sheets being "welded". The water is considered dirty or aqueous solutions when the cover is used with a pond or other liquids.

Alternatively, if applicant wishes to argue that Dearing does not at least inherently provide dirty water, it would have been obvious at the time of the invention to one having ordinary skill in the art that the cover system of Dearing could have been used to cover dirty water such as that in a settling pond for holding sewage and industrial wastes. It would have been obvious because Dearing suggests at column 1, line 34 his cover may be used on ponds which is considered to include all ponds, dirty

or clean. Further, it is desirable to provide cover systems on settling ponds to maintain appropriate temperatures to enable bacteria to decompose the material within the pond.

8. Claims 8, 21, 30 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent. 4,197,595 to Dearing.

Dearing provides each of the elements of the claims as noted above except for the claimed panel dimensions and securing or anchoring to an anchoring trench. The claimed dimensions are viewed as nothing other than a choice of design, which would have been obvious at the time of the invention to one having ordinary skill in the art. Dearing recites preferred dimensions but suggests several dimensions are possible.

Applicant's Summary and Background of the Invention recites that it was known in the art at the time of the invention to secure pond covers to an anchoring trench. As such, it would have been obvious at the time of the invention to one having ordinary skill in the art to have secured the cover assembly of Dearing to an anchoring trench when used in a pond environment.

9. Claims 5-7, 9, 14, 15, 18, 19, 21, 24-29, 31, 36-38, 42, 43, 47 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,438,863 to Wilson et al.

Wilson provides panels 10 overlying dirty water (column 1, lines 61+) in a pond/tank 12. Figure 8 shows adjacent edges of the panels having

opening/grommets 76 linked or secured with fastener 70/72. The panels themselves are inherently a means for controlling temperature and anchor means/trench 20 is provided.

10. Claims 8 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,438,863 to Wilson et al.

The claimed dimensions are viewed as nothing other than a choice of design, which would have been obvious at the time of the invention to one having ordinary skill in the art. It would have been obvious at the time of the invention that the panels 10 could be dimensioned as required.

11. Applicant's arguments filed 12/24/04 have been fully considered but they are not persuasive.

The rejections based upon U.S. Patent 4,590,714 to Walker have been overcome by the amendment of claims 5 and 28. Walker fails to adequately teach or suggest covering water.

A supplemental oath/declaration is required each and every time the application is amended. If not provided it is proper to reject the claims under 35 U.S.C. 251 and require a supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Applicant's argument that making the next office action final would be improper because the issue of dirty water has been previously raised is not found persuasive.

The amendment of 12/24/05 changed the scope of at least claim 5 and any new rejection would have been necessitated by amendment. However, the instant Office action is not made final because the examiner inadvertently omitted the numbers of the claims in the rejection set forth in paragraph 12 of the last office action and has added rejections using Wilson '863 for the first time.

It is noted that since applicant has not traversed the examiner's assertions of Official Notice in the last Office action the statements are taken to be admitted prior art. MPEP 2144.03

The Degarie declaration under 37 CFR 1.132 originally filed in Reexamination Control No.: 90/005,369 is insufficient to overcome the rejection of claims 5, 28 and their respective dependents based upon Dearing '595 as set forth in the last Office action because: It refers only to "dirty water" and "clean water" systems and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. The declaration not only fails to address the claims of the instant invention but fails to address the specific references upon which the rejections have been based. The declaration has been considered to the extent that it is Mr. Degarie's *opinion* that the fields of "dirty water systems" and "clean water systems" are non-analogous arts. Evidence of secondary considerations is irrelevant to the 35 U.S.C. 102 rejections and thus cannot overcome rejections so based. Arguments of non-analogous art or not recognizing the problem solved are not germane to rejections under 102. References are still anticipatory if they explicitly or inherently disclose every limitation recited in the

claims. In the instant case it is the examiner's position that "dirty water" is at least inherently disclosed in Dearing '595 by the language "covers floating on water or other liquids" (Column 1, line 9) and "for use on ponds" (Column 1, line 34). Under 35 U.S.C. 103, in order to rely on a reference for a basis for rejection the reference must be in the filed of applicant's endeavor or reasonably pertinent to the particular problem with which the invention is concerned. Clean water cover systems are considered reasonably pertinent to dirty water cover systems. See MPEP § 716, 2131.05, 2141.01.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J Canfield whose telephone number is 703-308-2482. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield  
Primary Examiner  
Art Unit 3635

